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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,792	08/25/2006	Wayne H. Rothschild	247079-000295USPX	1114
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NIXON PEABODY LLP 300 S. Riverside Plaza 16th Floor CHICAGO, IL 60606			EXAMINER MOSSER, ROBERT E	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 02/17/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/590,792	Applicant(s) ROTHSCHILD ET AL.	
	Examiner ROBERT MOSSER	Art Unit 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/21/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,21-26 and 35-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13,21-26 and 35-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-2, 4-13, 21-26**, and **35-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano Jr. (USP 6,811,486) in view of Baerlocher et al (USP 5,788,573).

Claims **1-2, 10, 22, 35**, and **39**: Luciano teaches a method and apparatus for conducting a wagering game including:

receiving wagers/bets from a player, via a user interface, for each play of a game;

randomly determining a first game outcome on a first machine;

providing the player a game asset if the first outcome matches a predetermined outcome wherein the game asset alters a second game outcome and wherein further the game asset indicates a segment that the player is eligible to play;

randomly determining a second game outcome on the first machine or a second machine through the use of a processor;

receiving the game asset from the player and modifying the game outcome responsive to the receipt of the game asset; and

awarding the player for winning game outcomes (*Luciano* Abstract Col 1:23-2:14, 5:1-15, 5: 56-6:44; 8:8-29 Figure 5, 7, 8).

The prior art of *Luciano* does not explicitly teach that the game segment is part of a plurality of game segments each respectively associated multiple award amounts however, *Baerlocher* (US 5,788,573) teaches the presentation of a bonus game including a plurality of segments with each respectively associated multiple award amounts (*Baerlocher* Figures 1, 4, 6 Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the presentation of a bonus game including a plurality of segments with respectively associated multiple award amounts as taught by *Baerlocher* into the invention of *Luciano* in order to provide a bonus game with randomly selected prize amounts in a bonus game.

**Claims 4 and 23:** The combination of *Luciano* and *Baerlocher* teaches the transfer of game assets using ticket based embodiments (*Luciano* Figure 3 Col 7:9-21).

**Claim 6:** The combination of Luciano and Baerlocher teaches the transfer of game assets using player IDs and player ID readers (*Luciano* Col 8:58-9:18 10:44-58).

**Claims 7-9, and 37:** The combination of Luciano and Baerlocher further teaches the awarding of modified game outcomes (*Luciano* Figure 9, Col 9:19-47), altering the secondary game outcomes through the use of a game asset to return and progress from a previously terminated game state (*Luciano* Figure 9, Col 9:19-47), and wherein multiple award amounts increase as players progress through the series of game segments (*Baerlocher* Figure 5)

**Claims 10-13:** The combination of Luciano and Baerlocher teaches that the player may receive a plurality of game assets and redeem a portion or all of their game assets as desired (*Luciano* Figures 7-8; Col 8:12-23; 12:20-13:9).

**Claims 21, and 25-26:** The combination of Luciano and Baerlocher teaches the use of a plurality of game levels including the incorporation of bonus games and assets that provide instant bonus game plays and wherein further the base game and bonus games are understood to have respective prizes associated therewith (*Luciano* Col 8:30-47, 9:19-47 *Baerlocher* Figure 5).

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Claim **36**: The combination of Luciano and Baerlocher teaches the invention as set forth above including the awarding and distribution of prize resultant of the secondary game outcome. While the combination of Luciano and Baerlocher is silent regarding explicitly teaching the awarding of two prizes however it would have been obvious to one of ordinary skill to award two prizes because the awarding of the second prize would have represented the mere duplication of parts with no new and unexpected result (2144.04.VI.B), and doubled the amount of awards received by the player for participating and attaining a winning game state thereby providing additional incentive for player participation based on the awarding of a prize as originally taught by the combination of Luciano and Baerlocher.

Claims **38**, and **40-41**: The combination of Luciano and Baerlocher further teaches that the game asset may have various effects including: the designation of a wild symbol; transposition or re-spinning of game symbols; the addition of paylines; altering the probability and size of the award (changing payable); providing the player with a predetermined game segment or bonus game; payline multipliers, and adding value to a bonus game outcome through the altering of bonus game pay tables (*Luciano* Figure 5 Col 8:30-47).

Claims **5** and **24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano Jr. (USP 6,811,486) in view of Baerlocher et al (USP 5,788,573) as applied to at least claims 1, and 21 above, and further in view of Baltz et al (US 6,852,029).

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The combination of Luciano and Baerlocher teaches the invention as taught above including the incorporation of a bill validator and ticket reader (*Luciano* Elm 106, 204 Col 5:56-6:26), however the combination of Lucian and Baerlocher does not explicitly teach merging of the bill validator and ticket reader into a singular device. In a related invention Baltz teaches a device for use with electronic gaming machines adapted to provide a bill validator and ticket reader in a singular device such that the bill validator is operable to read printed tickets (*Baltz* Elm 316). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the bill validator and ticket reader as a singular device such as taught by Baltz into the combination of Luciano and Baerlocher in order to remove the added cost of incorporating two separate readers.

### ***Response to Arguments***

Applicant's arguments filed 10/21/2009 have been fully considered but they are not persuasive.

The applicant presents on pages on 9 and of their remarks that the modification of Luciano to include the newly claimed features would change the principle of Luciano's invention and/or render it unsatisfactory for its intended purpose. This argument is respectfully non-persuasive as the particular secondary/bonus game utilized is non-critical to the invention of Luciano while further the addition of the bonus game as taught by Baerlocher has not been shown to change the principle of, or render unsatisfactory for use, the invention of Luciano.

The remainder of the applicant's remarks presented on pages 9 through 12 argue claim limitation as newly presented and redressed in the rejections above through the incorporation of Baerlocher.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/  
Supervisory Patent Examiner, Art  
Unit 3714

/R. M./  
Examiner, Art Unit 3714